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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,536	10/16/2001	Steven C. Wasserman	14531.47.1	5260

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EXAMINER

GURSHMAN, GRIGORY

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 04/28/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/978,536	WASSERMAN	
Examiner	Art Unit	
Grigory Gurshman	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 13 April 2004.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 2-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 2-22 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant has submitted no amendments to claims 2-21. New claim 22 has been added. Claim 22 merely recites a computer program product of claim 12. All of the limitations of claim 22 are identical to those of claim 15 dependent on 12, therefore prior art of record applies to claim 22 in the same manner as to claims 12 and 15 as stated in the rejection herein.
2. Referring to independent claims 2,8,12 and 18, Applicant argues that the *prima facie case* of obviousness has not been sufficiently established since there are some differences between the claimed invention and the prior art of record. Examiner respectfully disagrees and points out that while there may be some technical features of Applicant invention that are different from prior art of record, they are not sufficiently reflected in the claims. Examiner uses broad but reasonable interpretation of the claim language. For example the limitation:

“generating a server authentication request at the client;
transmitting the server authentication request to the server”

is met by a logon ID transmitted from the client workstation to the server workstation (see Fig.2. block 31). The limitation “...receiving an encrypted server authentication response from the server...” is met by encrypted password received from the server workstation (see Fig. 2, block 35). The limitation “...decrypting the server authentication response...” is met by password entered by the user at workstation (11 in Fig.1), which is used to decrypt the encrypted password received from the server workstation (see Fig.2, block 35).

3. Applicant further argues that the motivation to combine references is taken from Applicant' disclosure and based on hindsight reasoning. Examiner respectfully disagrees and points that while Kung does not teach disabling client functions if the server is not authorized to provide resource to the client, McAuliffe discloses an advertisement authentication system, in which advertisements are downloaded for off-line display (see abstract and Fig. 1A). McAuliffe shows a client computer connected to the server computers over the network (see units 2 and 20, 22, 24, 25, 27 in Fig. 1A). McAuliffe teaches advertisement authentication system capable of detecting various forms of advertisement and statistics file tampering. McAuliffe teaches that client software disabling are instituted after multiple incidents of "tampering" are detected within a short time period (see column 11, lines 9-12).

Examiner maintains, that one of ordinary skill in the art would have been motivated to disable client functions in case of a negative result of authentication as taught in McAuliffe for making sure that the advertisements are properly displayed at a remote computer (see McAuliffe, abstract). As shown, here the motivation to combine the teachings of Kung with those of McAuliffe is taken directly from teachings of McAuliffe and not from the Applicant's disclosure.

4. Applicant states that even assuming *arguendo* that the combination of Kung with McAuliffe is proper, they fail to teach or suggest all of the limitations of the independent claims 2, 8, 12 and 18 as well as dependent claims 7 and 17. Examiner once again points out that appropriately broad interpretation of the claims is applied. It was explicitly stated in the first Office Action, and repeated herein, that limitations of the instant claims are met by the elements of the prior art.

5. Rejection of claim 2-22 is maintained.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-5, 7-10, 12-15, 16-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung (U.S. Patent No. 5.434.918) in view of McAuliffe (U.S. Patent No. 5.838.790).

8. Referring to the instant claims Kung discloses a method for providing mutual authentication of a user and a server on a network (see abstract and Fig.1).

Kung teaches a mutual authentication method for use in authenticating a user that operates a client workstation that is coupled to a file server workstation having a password file comprising a password known to the user (see Fig. 1 and column 1, lines 47-50). Kung teaches that the method comprises the following steps: A logon ID is transmitted from the client workstation to the server workstation. The stored user password corresponding to the user ID is retrieved using the transmitted logon ID is retrieved from the password file. A random number is created that is encrypted by a symmetric encryption algorithm on the server workstation using the retrieved user password, and which provides an encrypted password. The user is then requested to enter the password into the user workstation. The entered password is used to decrypt the encrypted password received from the server workstation and retrieve the random number

therefrom to authenticate the server workstation. The random number is then used as the encryption and decryption key for communication between the user and server workstations. An encrypted message is transmitted using the random number from the client workstation to the server workstation. The encrypted message is decrypted at the server workstation to authenticate the user (see column 1, lines 53-68).

9. Referring to claims 2, 5, 8, 12, 15, 18, 20 and 22 the limitation "generating a server authentication request at the client; transmitting the server authentication request to the server" is met by a logon ID transmitted from the client workstation to the server workstation (see Fig. 2, block 31). The limitation "...receiving an encrypted server authentication response from the server..." is met by encrypted password received from the server workstation (see Fig. 2, block 35). The limitation "...decrypting the server authentication response..." is met by password entered by the user at workstation (11 in Fig. 1), which is used to decrypt the encrypted password received from the server workstation (see Fig. 2, block 35).

Kung, however, does not explicitly teach disabling client functions if the server is not authorized to provide resource to the client.

10. Referring to the instant claims, McAuliffe discloses an advertisement authentication system in which advertisements are downloaded for off-line display (see abstract and Fig. 1A). McAuliffe shows a client computer connected to the server computers over the network (see units 2 and 20, 22, 24, 25, 27 in Fig. 1A). McAuliffe teaches advertisement authentication system capable of detecting various forms of advertisement and statistics file tampering. McAuliffe teaches that client software disabling are instituted after multiple incidents of "tampering" are detected within a short time period (see

column 11, lines 9-12). Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify the system for authentication of a user and a server on a network of Kung by disable client functions in case of detection of tempering (i.e. negative result of authentication) as taught in McAuliffe. One of ordinary skill in the art would have been motivated to disable client functions in case of a negative result of authentication as taught in McAuliffe for making sure that the advertisements are properly displayed at a remote computer (see McAuliffe, abstract).

11. Referring to claim 4, 8, 9, 14, 18 and 19 the limitations "disable one or more functions until after a grace period" and " after an allotted period of time..." is met by disabling client functions after a number of incidents of "tampering" in a time period (see McAuliffe, column 11, lines 9 -12).

12. Referring to claims 5 and 10, McAuliffe shows the client authenticating the downloads from multiple servers (see units 2 and 20, 22, 24, 25, 27 in Fig. 1A).

13. Referring to claim 7 and 17, Kung teaches that a random number is created that is encrypted by a symmetric encryption algorithm on the server workstation using the retrieved user password, and which provides an encrypted password (column 1, lines 53-68).

14. Claims 6, 11, 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung (U.S. Patent No. 5.434.918) in view of McAuliffe (U.S. Patent No. 5.838.790) and further in view Guthrie (U.S. Patent No. 6.161.185).

15. Referring to the instant claims, Kung and McAuliffe teach disabling client functions when server authentication response fails to indicate that server is authorized to provide resources. Kung and McAuliffe, however, do not explicitly teach determining when a subsequent authentication response should occur

based on expiration information.

16. Referring to the instant claims, Guthrie discloses personal authentication system and method for multiple computer platform (see abstract). Guthrie shows a client-server system (see Figs. 1A and 1B). Guthrie teaches determining whether authentication request had been made during the expiration notification time (see column 9, lines 40-55). Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to have a server authentication response of Kung and McAuliffe comprising expiration information and to determine whether authentication response had occurred as taught in Guthrie. One of ordinary skill in the art would have been motivated to have a server authentication response of Kung and McAuliffe comprising expiration information and to determine whether authentication response had occurred as taught in Guthrie for allowing a user to attempt to authenticate himself for a configurable number of allowances after his password expiration time value has passed (see Guthrie column 9, lines 50-55).

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grigory Gurshman whose telephone number is (703) 306-2900. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Grigory Gurshman
Examiner
Art Unit 2132

April 26, 2004

GG



GILBERTO BARRON
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